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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,975	01/07/2002	Michael Rossides		7394

7590
Michael Rossides
11167 E. Mirasol Circle
Scottsdale, AZ 85259

08/23/2010

EXAMINER

RETTA, YIHDEGA

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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08/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/042,975

Applicant(s)

ROSSIDES, MICHAEL

Examiner

Yehdega Retta

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This office action is in response to amendment filed June 21, 2010. Applicant added claim 48. Currently claims 30-48 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flock*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

As the technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or filed of use) or mere implications of employing a machine or article or manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life

and meaning into the preamble. Therefore, the preamble is taken to merely recite a field of use.

The claimed limitation of entering an advertiser offer into the computer is considered insignificant extra solution activity and can not provide the basis for patentability under 101. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-48 are rejected under 35 U.S.C. 103(a) as being unpatentable Goldhaber U.S. No. 5,855,008, in view of Vance U.S. Patent No. 6,267,672.

Regarding claims 30 and 38, Goldhaber teaches (a) entering into the computer an advertiser offer that said recipients will be owed an amount of money if they pay attention to a specified ad message, and if they satisfy a set of at least one target audience characteristics; (b) stating said characteristics as a set of offer conditions by said advertiser (see col. 11 line 48 to col. 14 line 67); (c) specifying said amount of money as an expected value (EV) (see participant offered to be paid by advertiser for participant's identity and accepting the offer see col. 12 line 49 to col. 13 and col. 17 lines 9-37) (d) presenting an interface to the public for enabling anyone to access and accept said offer, (e) registering acceptance of said offer by a user called a recipient, said acceptance entailing: registering the recipient's identity (see col. 14 line 54 to col. 15 line 45). Goldhaber teaches in response to the participant paying attention to information the

information provider compensates the consumer (participant) (see col. 10 line 39 to col. 11 line 47). Goldhaber also teaches the attention brokerage server determines based on the interaction data whether the user's interaction with the advertisement was adequate (the adequacy of the interaction depends on particular requirements associated with the ad) and if the interaction was adequate the consumer account is credited (see col. 17 lines 38-57). Goldhaber also teaches the consumer selects for example a thumbnail and the consumer may also place an order for specific goods or services in response to the some displayed ads or interaction with tem (see col. 18 line 49-61). Goldhaber teaches advertiser pays a specified EV payment only to qualified, targeted recipients in exchange for their requesting a specified message (col. 5 line Goldhaber failed to teach expected value payment bet including a Payoff and executing the bet, determining whether said winner satisfies said condition and notifying a payment process for providing the Payoff to the recipient (winning participant). Vance teaches participant registering and providing participant's identity and accepting to be exposed to specific messages. Vance teaches consumer who has accessed the remotely accessible game receives advertising information (placement of commercial message such that they will be perceived by the participants (see col. 5 line 51 to col. 6 line 13). Vance further teaches that the participants become eligible for prizes; all consumers who access the game become eligible or participants of the prize can be randomly selected from those who have accessed the game. Vance also teaches that the prize eligibility may be governed in any of a number of ways. Vance also teaches that to prevent dishonest consumers from fraudulently claiming prizes, a consumer can be required to submit his or her access information prior to receiving the prize (see col. 6 lines 34-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Vance's

selection of a winner in Goldhaber's attention brokerage in order to limit the outcome. Also it would have been obvious to one of ordinary skill in the art at the time of the invention to implement Vance's verification of winners, in order to prevent dishonest consumers from fraudulently claiming prizes, as taught by Vance (see col. 6 lines 34-54). The claim recites if and only if said recipient wins said bet notifying the payment process for providing the Payoff to said recipient. But since the claim does not recite the participant pays attention to any message there is no eligible participant to win the bet. Therefore, none of the step claimed after the step of registering acceptance of the said offer by the user is performed. In order for the payment to happen the user should be exposed to a message.

Claims 31-37 and 39-48 are rejected under 35 U.S.C. 103(a) as being unpatentable Goldhaber U.S. No. 5,855,008, in view of Vance U.S. Patent No. 6,267,672 further in view of Landesmann (US 2003/0158,776 A1).

Regarding claims 31-37 and 39-48, Goldhaber does not teach wherein the characteristic is that the recipient purchase a specific product or service within specific time after exposure to said message. Examiner points out that the claim only recite that the offer condition includes that the participant purchases a product within a specified period of time after the participant is exposure to said message however the claim does not recite the user is exposed to a message nor does it recite the participant purchases the product. No patentable weight is given to a written contract, since it is a nonfunctional descriptive material. Thus, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (fed. Cir. 1994). Examiner also would like to point out that there is no

patentable difference whether the participant is a decision-maker for an organization, since the is no additional step or feature claimed by the system to differentiate a registered participant from being a decision-maker.

Landesmann teaches an incentive provided based on a buyer meeting predetermined criteria, such as based on first criteria of purchasing of a particular product or service and second criteria of a minimum number of products or services purchased in a predetermined time period (one or more rewards that are promised to a buyer in return for taking certain actions); an incentive for viewing and/or interacting with advertisements; rewards that are promised to buyer for responding in certain ways to the advertisement (see [0169]). It would have been obvious to one of ordinary skill in the art at the time of the invention to entice participants to purchase the products in Goldhaber by providing reward as in Landesmann in order to increase profit.

Regarding claim 48, since Landesmann teaches providing reward for purchasing a product (purchasing a product also include viewing the product which in on sale) Goldhaber as modified in view of Landesmann teaches providing the Payoff to said recipient after verifying that the recipient meet all the requirement for earning a reward.

Response to Arguments

Applicant's arguments filed June 21, 2010 have been fully considered but they are not persuasive.

Applicant states that in view of the recent Supreme Court decision in *Bilski et al.* Applicant does not believe that *Bilski* applies and is under the impression that the interpretation and application of *Bilski* are controversial. Examiner would like to point out that the Court correctly holds that the machine-or-transformation test is not the sole test for what constitutes a

patentable process; rather, it is a critical clue. But the Court of Appeals also affirmed the Board's decision.

Applicant also argues that Landesmann does not appear to be relevant prior art.

In response to applicant's argument that Landsman is nonanalogous art (not relevant prior art), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Landsman not only is in the field of applicant's endeavor (providing a reward after a potential consumers meet a pre-defined requirement .i.e., purchasing a product after viewing an ad for the product) also relevant to the particular problem with which the applicant is concerned (providing a reward to encourage the purchase of a product).

Applicant also states that Marshall's application (prior art made of record but not relied upon) is directed to tracking attention and does not think is relevant to the novelty of Applicant's claimed invention. Examiner respectfully disagrees as indicated in the office action Marshall is relevant to the application claimed invention since is related to providing reward consumer for their attention to advertisements.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622